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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,662	01/21/2004	David Kenneth Wolfe	DN0001	5787

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David L. King , Sr.  
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High Springs, FL 32643

EXAMINER
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MACKEY, JAMES P

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,662

Applicant(s)

WOLFE ET AL.

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/21/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of rotational molding, classified in class 264, subclass 310.
  - II. Claim 5, drawn to a rotational mold, classified in class 425, subclass 425.
  - III. Claims 6-16, drawn to an actuating venting assembly, classified in class 425, subclass 472.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and Groups II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case the apparatus as claimed can be used to practice another and materially different process such as one that does not require heating or cooling of the mold, or such as one that does not require venting upon a predetermined condition (i.e. venting at random times).

3. Inventions of Group II and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination mold does not require a venting assembly whose housing has an internal cylinder. The subcombination has separate utility such as a venting assembly for

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a non-rotational mold such as a tire vulcanizing mold, a mold for blow molding, or a gas-assisted injection mold.

4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with David King in January 2006, a provisional election was made without traverse to prosecute the invention of Group III, claims 6-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stem being “removable attached to the body of the piston” (claim 10) and the body of the piston and the stem being “separate but adjacent” (claim 15) must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.**

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. Claim 10 is objected to because of the following informalities: in claim 10, "removable attached" should be --removably attached--. Appropriate correction is required.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 6-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 2, "a housing having for attachment" is unclear and apparently incomplete.

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Claim 9 should depend from claim 8 in order to provide proper antecedent basis for “the piercing tip”.

In claim 11, line 3, “the internal cavity” lacks proper antecedent basis in the claim.

Claim 15 is indefinite in that the body of the piston and the stem being “separate but adjacent” is contrary to the claim recitation in independent claim 6 (lines 6-7) of “the stem extending from the body of the piston”.

In claim 16, --said-- should be inserted before “vent passages” to clearly refer to the previously-recited vent passages (see claim 6 at line 5).

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 6, 8, 10, 11, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (U.S. Patent 5,482,721; Figures 3-5).

Clark et al. teach an actuating venting assembly 98 comprising a housing 125 having means 100 for attachment to an opening in a mold, the housing having an internal cylinder 140; a movable piston including a body 136 mounted in the internal cylinder and a stem extending from the body, a threaded attachment of the stem to the piston body being clearly shown in Figures 3 and 5 (such threaded attachment being an “integral” attachment as claimed in claim 14; see *In re Clark*, 102 USPQ 241; *In re Kohno*, 157 USPQ 275; *In re Dike*, 157 USPQ 581; and *In re Hotte*, 177 USPQ 326), the stem having vent passages 112 comprised of longitudinally extending grooves; and a piercing tip 120 located at the distal end of the stem. Note that pneumatic inlet

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aperture 152 communicating with the mold-side of the internal cylinder reads on the piston retraction means for moving the piston away from the mold cavity as claimed in claim 11.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. (U.S. Patent 5,482,721; Figures 3-5).

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Clark et al. disclose the actuating venting assembly substantially as claimed, except for the piercing tip being removably attached to the stem (claim 9), and except for the piston retraction means being a spring (claim 12). However, with regard to the piercing tip being removably attached to the stem, it has been held to be within the general level of skill in the art to provide a structure as being made of separable portions (see *In re Dulberg*, 129 USPQ 348), and it would have been obvious to a skilled artisan to have provided the piercing tip 120 of Clark et al. as being removably attached (i.e., separable) in order to facilitate repair or replacement of the stem tip without requiring removal of the entire stem or piston assembly. With regard to the piston retraction means being a spring, it would have been obvious and well within the level of ordinary skill in the art at the time of the invention to modify Clark et al. by providing the means to retract the piston as a spring, since such were equivalent means for applying a retracting force to the piston, and thus to the stem, to bias the piston and stem away from the mold cavity; in other words, mechanical spring piston retraction means are known equivalents to pneumatic piston retraction means, and it would have been obvious to a skilled artisan to utilize either of the known equivalents in the venting assembly of Clark et al. for the same purpose.

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al. (U.S. Patent 5,482,721; Figures 3-5) in view of Boyce et al. (U.S. Patent 6,280,176).

Clark et al. disclose the actuating venting assembly substantially as claimed, except for the piercing tip being made of PEEK or PTFE. Boyce et al. disclose a mold vent being made of heat-resistant PEEK or PTFE. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Clark et al. by providing the piercing tip as being made of



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either PEEK or PTFE in order to provide a heat resistant venting assembly, as suggested by Boyce et al.

18. Claims 7 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach or fairly suggest an actuating venting assembly wherein the stem is a hollow tube having one or more venting passages adjacent to the distal end and one or more venting passages in proximity to the piston body in communication through a central opening or bore end in the hollow tube, as claimed in claim 7, or wherein the body of the piston and the stem having vent passages are separate but adjacent, as claimed in claim 15.

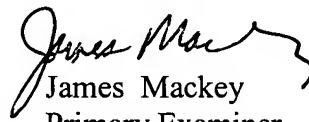
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
James Mackey  
Primary Examiner  
Art Unit 1722  
2/14/06

jpm  
February 14, 2006